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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,726	02/08/2002	Jeffrey R. Moritz	P00548-US-1 (14913.0020)	3222
28078	7590	08/08/2006	EXAMINER	
MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204			GORDON, BRIAN R	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 08/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/071,726

Applicant(s)

MORITZ ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2-23-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-12, 33 and 34 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4-20-05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-12, 21--34 have been considered but are moot in view of the new ground(s) of rejection. In view of the fact Asa et al. US 6,098,802 discloses a pipette rack comprising an insert the claims have been rejected as given herein.

### ***Drawings***

1. The drawings were received on April 20, 2005. These drawings are acceptable.

### ***Claim Interpretation***

2. The claims recites the rack is for holding a plurality of pipette tips. The "for" clause in the preamble expresses intended use of the device.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

As to the functionality of the device being intended for specifically dissipating a charge from a pipette tip.

The functional recitation that the rack discharges a static electrical charge deposited on a pipette tip has not been given patentable weight because it is in narrative form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC 112, 6<sup>th</sup> paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. In *re Fuller*, 1929 C.D. 172; 388 O.F.279.

The examiner interprets any prior art structure that has a face having a plurality of seats, at least one sidewall depending from the face and wherein the side face and side wall of being comprised of an electrically conductive plastic as meeting the limitations of claim.

As to the recitation of the seats are designed and dimensioned to hold pipette tips and the rack is dimensioned to dissipate static electricity. The claims do not specify any numerical values for the dimensions which would be considered adequate to achieve the cited results. The claims do not further structurally limit the device but moreso express intended use. Pipettes may be molded or manufactured a various sizes therefore any rack opening may be considered suitable for holding pipette tips and dissipating electrical charges.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 33-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-7 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asa et al. US 6,098,802 and further in view of Mehra or Pearlman.

Asa et al. discloses a deep well rack assembly for pipette tips, which comprises: (a) a lower enclosure base having an upper wall with a plurality of openings defined therein; (b) a plurality of lower wells disposed within the lower enclosure base and being attached to and extending below the upper wall of the lower enclosure base, each of the lower wells including a continuous side wall having an open top end extending around a respective one of said openings

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in the upper wall of the lower enclosure base; (c) an upper enclosure insert having a top wall with a plurality of openings defined therein; and (d) a plurality of upper wells disposed within the upper enclosure insert and being attached to and extending below the top wall of the upper enclosure insert, each of the upper wells including a continuous side wall having an open top end extending around a respective one of the openings in the top wall of the upper enclosure insert, the upper enclosure insert being removably installable over the lower enclosure base with the upper wells of the upper enclosure insert nestably received into the lower wells of the lower enclosure base (see abstract; passage beginning at column 8, line 41).

Asa discloses all of the limitation of the claimed invention except reciting the device is manufactured from an electric conductive material.

Mehra discloses a single-piece, injection molded rack for holding test tubes or similar articles and a mold for producing the same.

As shown in FIG. 2, the rack includes a top tier 12, an intermediate tier 14, and a bottom tier 16, selectively interconnected in spaced-apart, superposed relation. For holding test tubes or similar articles, the top tier 12 and intermediate tier 14 have apertures 11 (forming seats) and 13, respectively.

The rack also includes sidewalls or supports 20.

The rack in accordance with the invention can be made from any suitable injection molding material, such as, for example, polyethylene, polypropylene, polystyrene, high-impact polystyrene, polycarbonate, polyamides, polyacetals, polyurethane, and the like. The injection molding material can also contain fillers, glass fibers, carbon black, carbon fibers, boron fibers,

silica, titanium dioxide, and the like. Glass fibers are a preferred filling material (column 10, lines 26-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the tip rack of Asa et al. may be manufactured from the moldable plastic materials as discloses by Mehra and Pearlman.

It would have further been obvious to optimize the amount of carbon black embedded within the rack in order provide sufficient strength to support he weight of the articles held therein.

Mehra does teach modifications may be particularly desirable where the mold is to be used to provide a rack that is to be used for purposes other than holding test tubes. For example, such modifications may be useful in packaging, storage, and shipping of various kinds of containers for liquids and the like. It is fully intended that the inventive concepts for both the rack and mold not be limited merely to the holding of test tubes (column 17, lines 4-12).

Therefore the rack may be capable of holding pipette tips and various other items.

Asa et al. do not disclose the insert panel as comprising polypropylene.

Pearlman teaches many racks for vials fall into two structural types (see above Fisher Catalog). One type consists of an injection-molded solid or hollow plastic block, e.g., molded polyethylene, polypropylene, polycarbonate, or acrylic, containing a rectilinear array of cylindrical holes to support cylindrical and conically bottomed specimen vials. Also described is a rack made of polyester foam, which has resilient sockets. Another type of rack is reminiscent of a traditional rectangular test tube rack, and contains square openings.

A sheet material, such as 2-6 pound per cubic foot density closed-cell polyethylene, polypropylene, or a copolymer foam material between approximately 1/16 and 1 inch thick, is selected which can be readily perforated with round or square holes (e.g., by die-cutting), and which retains long term elastic memory following linear compression and/or extension of up to at least 25%.

It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture panel 2 (insert) of Asa et al. from polypropylene to readily allow holes to be cut into it to accommodate the tubes.

***Allowable Subject Matter***

6. Claims 8-12 and 33-34 are allowed.
7. The prior art of record does not teach nor fairly suggest the rack comprises a support insert comprising a plurality of support walls that form chambers (or individual, separate compartments) dimensioned to receive pipette tips.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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